

### **Remarks**

This Amendment is in response to the Office Action dated **September 12, 2008**. Claims 1-26 and 58-60 are pending in this application. The Office Action rejected claims 1, 5, 6, 18-20 and 60 under 35 USC § 102 over Matthews (US 4739769); rejected claims 2-4, 7-10 and 14 under 35 USC § 103 over Matthews in view of Fulton (US 6074374); rejected claim 11 under 35 USC § 103 over Matthews in view of Fulton and further in view of Follmer (US 5728065); rejected claims 12, 13, 15 and 17 under 35 USC § 103 over Matthews in view of Follmer; rejected claims 16 and 58 under 35 USC § 103 over Matthews in view of Follmer and Chee (US 5906606); rejected claims 21-24 under 35 USC § 103 over Matthews in view of Imran (US 5766203); rejected claims 25 and 26 under 35 USC § 103 over Matthews in view of Hamilton (US 6514228); and rejected claim 59 under 35 USC § 103 over Matthews in view of Follmer and further in view of Chee.

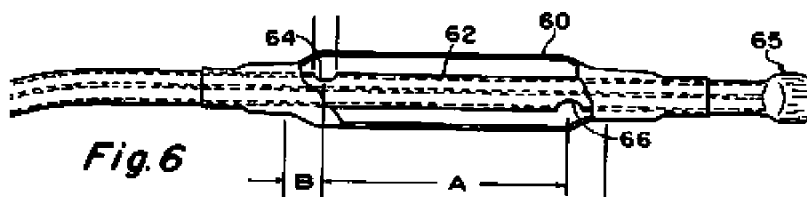
By this Amendment, claim 1 is amended for clarification purposes. Reconsideration in view of the above amendment and the following remarks is requested.

### **Claim Rejections (Independent Claim 1)**

This section discusses the rejection of independent claim 1 and all claims dependent therefrom, under 35 USC §§ 102 & 103. Although the rejections are traversed, claim 1 has been amended for clarification purposes to further prosecution of the application. The amendment is believed to have rendered the rejections moot.

Claim 1 recites a “guidewire lumen” extending through the catheter tip, and further specifies that each “recessed portion” extends around “a full outer periphery of the catheter tip.”

The rejections cite to Matthews Figure 6, provided below, asserting that reference characters 64 and 66 indicate the “recessed portions” recited in claim 1. See e.g. Office Action at page 2.



Matthews teaches that reference characters 64 and 66 indicate holes/ports that

provide fluid communication between the inflation lumens 61, 63 via the balloon/chamber 60. See column 6, lines 3-23.

The amendment to claim 1 specifies that the claimed “recessed portions” extend around the full outer periphery of the catheter tip. The holes/ports 64 and 66 shown in Figure 6 do not extend as claimed. Thus, Matthews does not disclose or suggest each limitation recited in claim 1. Matthews also does not disclose or suggest a guidewire lumen, as recited in claim 1. Therefore, claim 1 and all claims dependent therefrom are patentable over Matthews under 35 USC § 102.

The amendment to claim 1 is further believed to have rendered moot the rejections under 35 USC § 103. For example, none of the rejections asserted in the Office Action propose to modify the Matthews device in a way that would result in a catheter tip that meets the limitations of claim 1. Accordingly, Applicant requests withdrawal of the rejections under 35 USC §§ 102 & 103 of claim 1 and claims 2-15, 17-26, 59 and 60, dependent therefrom.

#### **Claim Rejections (Independent Claim 16)**

The Office Action rejected claims 16 and 58 under 35 USC § 103 over Matthews in view of Follmer and Chee. These rejections are traversed.

The rejection admits that Matthews does not disclose or suggest regions of differing flexibility, and proposes to modify Matthews to add regions of different stiffness as taught by Follmer. See e.g Office Action at page 4.

A person of ordinary skill in the art would not have modified Matthews as proposed because the Matthews device and the Follmer device perform different functions and serve different purposes. The reason for having varying stiffness in the Follmer device is not relevant to the Matthews device.

Matthews teaches a tissue pressure measurement transducer system for measuring tissue pressure in muscle compartments. See column 1, lines 10-12. The Matthews measurement catheter is generally inserted into muscle tissue using a needle that surrounds the balloon/lumen assembly. After the initial insertion, the needle is removed, and the pressure of the muscle tissue can be measured. See column 3, lines 8-16. Thus, the measuring catheter does not rely upon its own stiffness, but upon the stiffness of a separate needle during insertion. Further, the insertion

depth is relatively shallow.

Follmer teaches a balloon catheter that is generally guided to various target sites within a patient's body by navigating the vascular system using minimally invasive surgical techniques. See column 1, lines 11-17.

A person of ordinary skill in the art would recognize that the stiffness teachings of Follmer, while relevant to a catheter that is advanced through relatively long lengths of blood vessel, would not be relevant or beneficial in Matthew's shallow muscle tissue measuring device. There is no need to modify the stiffness of the Matthews device, as it relies upon a separate insertion needle – the modification would be fruitless. Therefore, a person of ordinary skill in the art would not have modified Matthews as proposed in the rejection, and the Office Action has not provided a clear reason why a person having common sense would have been prompted to modify Matthews in a way that would result in a device that meets the limitations of independent claim 16. Accordingly, Applicant requests withdrawal of the rejection of claim 16, and claim 58 dependent therefrom, under 35 USC § 103.

**Conclusion**

Based on at least the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-26 and 58-60 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: December 12, 2008

By: /Jeremy G Laabs/  
Jeremy G. Laabs  
Registration No.: 53170

6640 Shady Oak Dr., Suite 400  
Eden Prairie, MN 55344-7834  
Telephone: (952) 563-3000  
Facsimile: (952) 563-3001

f:\wpwork\jgl\10813us01\_and\_20080917.doc